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10/654,887

09/05/2003

Valerie De La Poterie

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04/01/2008

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/654,887 | Applicant(s) DE LA POTERIE ET AL. | |
| | Examiner JYOTHSNA A. VENKAT | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) 32-72 and 101-105 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 73-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/05 and 1/11/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1615

DETAILED ACTION

Receipt is acknowledged of election filed on 1/11/07 (with respect to groups) and election filed on 7/30/07 (with respect to single disclosed species, Kester wax). Receipt is also acknowledged of IDS filed on 3/31/05 and 1/11/07.

Claims 1-105 are pending in the application and the status of the application is as follows:

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 1/11/07 is acknowledged. The traversal is on the ground(s) that the at a minimum, examining the claims of Groups I and III-V together would not impose a serious burden since Groups I and III-V fall into the same "class 424, subclass 70.7 and additionally no serious burden would exist in light of the requirement of rejoinder. This is not found persuasive because art anticipating a composition of group I would not anticipate or render obvious group II since both the groups use distinct compounds. Art anticipating or rendering composition claims would not anticipate or render obvious method of use claims or apparatus claims. It is a search burden to examine all the groups in patent and non-patent literature. With respect to no burden exist in light of rejoinder; the claims are not allowable therefore there is no rejoinder at this stage of prosecution. The requirement is still deemed proper and is therefore made FINAL.

Claims 32-72, and 101-105 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/11/07.

Art Unit: 1615

With respect to restriction between species applicants argue that the identified species are related by operation and/or effect and it is not a search burden to examine all the species and therefore division of each of these species is unsupported and improper.

This is not persuasive as the composition can have wax, which is natural or synthetic wax or wax of formula I. Examining all these species is search burden.

Claims 1-31 and 73-100 are pending in the claims and the generic claims will be examined to the extent that it reads on Kester wax (also known as synthetic bees wax).

Priority

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), Applicant must provide a certified English translation of the provisional applications. Further, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Art Unit: 1615

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(0) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-31 and 73-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent 5,985,298.

Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions and these compositions have wax. The compositions have volatile solvent and non-volatile oil, film former and emulsifier (surfactant claimed in claim 95). The waxes include Kester wax,

Art Unit: 1615

which is also known as synthetic bees wax. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent). Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 46-48). The weight percent of the solvent is also within the claimed range. Mascara composition has film former, which is polyethylene. Patent Example 2 has 4 types of waxes. Example 2 has carnauba wax and candelillia wax claimed in claims 28-31. The weight percent disclosed in example 2 is within the weight percent claimed. Example 2 has additional wax which is claimed in claims 91-94. The weight percent disclosed in example 2 is within the weight percent claimed. Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 46-48). The weight percent of the solvent is also within the claimed range. See also col.6, line 50 through col.7, line 32. See all the examples. The combination of volatile oil and non volatile solvent belongs to claimed fatty phase. See col.2, line 20 through col.4, line 21 for fatty phase. See col. 4, ll 22-24 for the various cosmetic products. Patent also teaches film formers at paragraph bridging col.s 5-6 and teaches that various film formers disclosed in CTFA handbook can be used. Patent teaches cellulose derivatives and this belongs to claimed cellulosic polymers.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute synthetic bees was for bees wax or synthetic wax taught in the mascara compositions . One of ordinary skill in the art would substitute the functional equivalents expecting that the synthetic bees wax can also be used in composition. With respect to limitation claimed in claims 32-38, patent office is not equipped to measure tack, hardness measurement discussed at pages 6-7 of the specification. This is a prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 and 73-100 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32-38 and 45-58 of copending Application No. 10/654,907. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions claimed in the co-pending application and the instant application. In the co-pending application the composition has solid content and adhesion profile. Both these parameters are measured using protocols. Both the instant application and co-pending application use Kester bees wax, film forming polymer and other additives in the compositions therefore the instant application composition will also have the same solid content and adhesion profile claimed in the co-pending application since the components are same and both the compositions are useful for coating keratin fibers or for various make up compositions. The composition

Art Unit: 1615

claimed in the instant application anticipate the composition claimed in the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615

Application/Control Number: 10/654,887
Art Unit: 1615

Page 8